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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,396	03/29/2000	Pramod B. Mahajan	1116	6440

27310 7590 01/16/2004

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EXAMINER

IBRAHIM, MEDINA AHMED

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/538,396

Applicant(s)

MAHAJAN ET AL.

Examiner

Medina A Ibrahim

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): 112, 1<sup>st</sup> paragraph rejections to claims 18-19 and 21-22.
4. ☒ Newly proposed or amended claim(s) 19,21 and 22 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: 18,19,21 and 22.Claim(s) rejected: 2-8,12,14,20 and 23-38.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☒ Other: See Continuation Sheet

Continuation of 5. does NOT place the application in condition for allowance because: arguments regarding 112, 1s paragraph rejections to claims 2-8, 12, 18, 20, 23-38 are duplicatives of what have been already addressed in previous Office actions. Applicant has provided no scientific evidence to support the conclusion that any and all sequences having at least 90% sequence identity to SEQ ID NO:1 or 2, and any and all polynucleotides that hybridize to SEQ ID NO:1 under the conditions as set forth in the claims, would retain the desired MRE11 binding activity. Note, claim 18, drawn to a polynucleotide sequence having at least 95% sequence identity to SEQ ID NO:1 is not supported by an enabling disclosure because the specification does provide sufficient guidance for the regions of the full length sequence of SEQ ID NO: 1 which would tolerate modifications. The written description standard as set forth in the 35 U.S.C. 1112, described MPEP, and shown in Example 14 of the Revised Interim Written Description Guidelines does not support sequences with 90% identity as claimed in claims 12 and 20, and sequences with 95% identity at the nucleotide level as claimed in claim 18.

Continuation of 10. Other: The enablement rejection to claims 18-19 and 21-22 has been withdrawn in view of Gallego et al reference (The Plant Journal, 25(1) pp. 31-41, 2001). Scope of enablement rejection is maintained for claims 2-8, 12, 14, 20 and 23-38 for the reasons set forth in the last Office action of 01/13/2003.



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